

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
John C. Harvey *et al.*

Application No.: 08/448,644

Confirmation No.: 9898

Filed: May 24, 1995

Art Unit: 2600

For: SIGNAL PROCESSING APPARATUS AND
METHODS

Examiner: James Groody

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR § 1.182

Pursuant to 37 C.F.R. § 1.182, the assignee of this application, Personalized Media Communications, LLC (“PMC” or “Applicant”), hereby petitions the United States Patent and Trademark Office (“PTO” or “Patent Office”) for relief not otherwise provided for under the PTO rules. Specifically, Applicant hereby petitions the Director, under 37 C.F.R. § 1.182, to withdraw the recorded terminal disclaimer before the above-referenced patent application issues as a patent.

I. Standard for Requesting Withdrawal of a Terminal Disclaimer

The Manual of Patent Examining Procedure (“MPEP”) § 1490 provides that “if timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent.” The MPEP further notes that because a terminal disclaimer does not take effect until after a patent is granted and the public has not thus relied upon the terminal disclaimer, relief from the entry of a terminal disclaimer, which is no longer appropriate or proper, is properly available through a petition.

The filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968). Further, MPEP § 1490 states that "there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues." The PTO has held that the proper time—and indeed the only time—a terminal disclaimer may be withdrawn is prior to the issuance of a patent. *Decision Denying Petition, In re Reissue Application of Lee et al, Reissue Application No. 09/933,918*, March 21, 2005 ("*Lee Decision*").¹ As demonstrated below, the Terminal Disclaimer filed in this application is no longer appropriate and should be withdrawn.

II. Factual Background

The Terminal Disclaimer in the above-referenced application was filed October 14, 1998 pursuant to 37 C.F.R. § 1.321(c), corrected an earlier filed Terminal Disclaimer July 29, 1998, and disclaimed, in essential terms, the terminal part of the statutory term of any patent granted on the above-referenced application, extending beyond the earliest expiration date of the full statutory term defined in 35 U.S.C. §§ 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on any of the then co-pending applications of the Applicant, i.e., the earliest expiration date for any patent which issued on any of the then co-pending applications.

This Terminal Disclaimer was filed in response to an Office Action mailed February 5, 1998, and supplementary to Applicant's Amendment and Request for Reconsideration dated April 6, 1998, and the Terminal Disclaimer and Supplemental Response and Request for Reconsideration filed July 29, 1998. The Office Action of February 5, 1998 contained a so-called "Administrative Requirement" which required the Applicant to either file a terminal disclaimer, to provide an affidavit attesting to the fact that no conflicting claims exist between co-pending applications, or to identify how all the claims in the instant application are separate and distinct from all the claims in the co-pending applications.

¹ The *Lee Decision* is a Final Decision from the Commissioner for Patents denying a petition to withdraw a terminal disclaimer via reissue because "petitioner knew, or should have known, [the withdrawal] had to be requested prior to issuance of the original patent". The *Lee Decision* further stated that "what is here controlling is that petitioner seeks to correct an issued patent", not a pending application as here.

At the time, Applicant chose to file the Terminal Disclaimer based on a clear understanding after a conversation with the examiner handling this application that its filing would place the application in a condition for issuance of a timely Notice of Allowance (See Supplemental Response filed October 14, 1998). No such Notice was ever issued. In fact, the further prosecution of this application has been delayed for the last twelve years as a result of suspended examination and other PTO actions.

By way of background, in November 1998, one month after the Terminal Disclaimer was filed, nine co-pending applications had been allowed, the issue fee was paid in six applications, and numerous other applications included claims directed to subject matter indicated to be allowable. Nonetheless, despite the PTO's clear indication in 1998 that dozens of applications contained allowable subject matter and would issue shortly thereafter, only one application ever issued (*i.e.*, U.S. Patent 5,887,243) and the PTO reversed its earlier position, withdrew the remaining allowed applications from issue and subsequently suspended prosecution on all but two of Applicants' pending applications.

III. Basis for Request for Withdrawal

Applicant respectfully requests withdrawal of the Terminal Disclaimer since more than eleven years have passed since its recordation and the claims in the above-referenced application have been amended at least twice, on March 15, 1999 and July 6, 1999. Further, in the course of prosecuting this application and its co-pending applications, the Applicant has agreed to incorporate the claims from at least twelve other corresponding applications (Application No. 08/460,732, Application No. 08/460,713, Application No. 08/448,833, Application No. 08/338,917, Application No. 08/458,566, Application No. 08/449,718, Application No. 08/448,794, Application No. 08/459,217, Application No. 08/459,507, Application No. 08/460,256, Application No. 08/448,976, and Application No. 08/460,765) and expressly abandon those applications. In Applicants' view, a simple comparison of the claims as they existed at the time of the Terminal Disclaimer and the claims as they exist now after the incorporation of twelve corresponding applications will demonstrate the merits of its current request.

In addition, many of the still co-pending applications have also since been suspended, amended, combined, allowed, withdrawn from allowance, appealed, and interviewed, thus

further fundamentally altering the circumstances that necessitated the original filing of the Terminal Disclaimer over a decade ago. For all these reasons, Applicant respectfully requests withdrawal of the Terminal Disclaimer.

Please charge the petition fee in the amount of \$400.00 to Deposit Account No. 50-4494. Please also charge any shortage in fees due in connection with the filing of this communication to Deposit Account No. 50-4494, and please credit any excess fees to such deposit account.

Dated: April 27, 2010

Respectfully submitted,

By /Thomas J. Scott, Jr./

Thomas J. Scott, Jr.

Registration No.: 27,836
GOODWIN PROCTER LLP
901 New York Avenue, NW
Washington, DC 20001
(202) 346-4000
Attorney for Applicants